

REMARKS

Sixty-two claims were originally filed in the present Application. Claims 1-22, 24-52, and 54-62 currently stand rejected. Claims 23 and 53 are objected to, but would be allowable if rewritten in independent form including all limitations of the base claim and any intervening claims. Claims 1, 4, 23, 31, 34, and 53 are amended herein. Reconsideration of the Application in view of the foregoing amendments and the following remarks is respectfully requested.

35 U.S.C. § 102(e)

In paragraph 1 of the Office Action, the Examiner rejects claims 1-22, 24-28, 30-52, 54-58, and 60-62 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,552,744 to Chen (hereafter Chen). The Applicant respectfully traverse these rejections for at least the following reasons.

“For a prior art reference to anticipate in terms of 35 U.S.C. §102, every element of the claimed invention must be *identically* shown in a single reference.” *Diversitech Corp. v. Century Steps, Inc.*, 7 USPQ2d 1315, 1317 (CAFC 1988). The Applicant submits that Chen fails to identically teach every element of the claims, and therefore does not anticipate the present invention.

Regarding the Examiner’s rejection of independent claims 1 and 31, Applicant responds to the Examiner’s §102 rejection as if applied to amended independent claims 1 and 31 which now recite “*at least one of said one or more image parameters corresponding to ambient lighting conditions that exist when said image data is captured*” which are limitations that are not taught or suggested

either by the cited references, or by the Examiner's citations thereto. Applicant submits that the foregoing amendments are supported by page 10, lines 23-26, of the Specification, and by claims 5 and 25, as originally filed, and therefore do not necessitate a new search.

Chen teaches a system in which "overlapping discrete images 35 can be combined based upon their spatial relationship to form a panoramic image 41." Chen states that the foregoing combination "is accomplished by determining a spatial relationship between the discrete images 35 based on the camera orientation information (column 5, lines 17-41). Chen is therefore limited to utilizing spatial relationships to create panoramas.

In contrast, as recited in amended claims 1 and 31, Applicant utilizes "image parameters" to create an optimal composite panorama image, where at least one of the image parameters corresponds to "ambient lighting conditions that exist when said image data is captured." Certain specific examples of the foregoing "image parameters" are recited in dependent claims 5 and 25, and include "an exposure parameter and a "white-balance parameter." Applicant therefore submits that amended independent claims 1 and 31 include limitations not taught or suggested by Chen.

With regard to claim 61, "means-plus-function" language is utilized to recite elements and functionality similar to those recited in claims 1 and 31 as discussed above. Applicant therefore incorporates those remarks by reference with regard to claim 61. In addition, the Courts have frequently held that "means-plus-function" language, such as that of claim 61, should be construed in

light of the Specification. More specifically, means-plus-function claim elements should be *construed to cover the corresponding structure, material or acts described in the specification*, and equivalents thereof.

Applicant respectfully submits that, in light of the substantial differences between the teachings of Chen and Applicant's invention as disclosed in the Specification, claim 61 is therefore not anticipated or made obvious by the teachings of Chen. Applicant specifically directs the Examiner's attention to Applicant's discussion of FIG. 5 which describes in detail certain aspects of the Applicant's claimed "means for selectively generating"

Regarding the Examiner's rejection of dependent claims 2-22, 24-28, 30-52, 54-58, and 60, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicant therefore respectfully requests reconsideration and allowance of dependent claims 2-22, 24-28, 30-52, 54-58, and 60, so that these claims may issue in a timely manner.

Because a rejection under 35 U.S.C. §102 requires that every claimed limitation be *identically* taught by a cited reference, and because the Examiner fails to cite Chen to identically teach or suggest the claimed invention, Applicant respectfully requests reconsideration and allowance of claims 1-22, 24-28, 30-52, 54-58, and 60-62, so that these claims may issue in a timely manner.

35 U.S.C. § 103

In paragraph 2 of the Office Action, the Examiner rejects claims 29 and 59 under 35 U.S.C. § 103 as being unpatentable over Chen in view of U.S. Patent No. 6,009,190 to Szeliski et al. (hereafter Szeliski). The Applicant respectfully traverses these rejections for at least the following reasons.

Applicant maintains that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a) which requires that three basic criteria must be met, as set forth in M.P.E.P. §2142:

"First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

The initial burden is therefore on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Applicant respectfully traverses the Examiner's assertion that modification of the device of Chen according to the teachings of Szeliski would produce the claimed invention. Applicant submits that Chen in combination with Szeliski fail to teach a substantial number of the claimed elements of the present invention. Furthermore, Applicant also submits that neither Chen nor Szeliski contain teachings for combining the cited references to produce the Applicant's claimed

invention. The Applicant therefore respectfully submits that the obviousness rejections under 35 U.S.C §103 are improper.

With regard to claims 29 and 59, the Examiner concedes that Chen nowhere discloses that “an image processing program on a remote computer device performs a transition processing procedure on adjacent frames of image data.” Applicant concur. The Examiner then points to Szeliski to remedy this defect.

The Court of Appeals for the Federal Circuit has held that “obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination.” In re Geiger, 815 F.2d 686, 688, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987). Applicant submits that the cited references do not suggest a combination that would result in Applicant’s invention, and therefore the obviousness rejection under 35 U.S.C §103 is improper.

The Examiner states that the motivation for combining the cited references “is to create full view panoramic mosaic image (sic) from plurality of images sequences.” Applicant respectfully submits that a *general restatement of the advantages disclosed by the Applicant* deriving from implementation of the present invention cannot act as the required teaching or suggestion to combine cited references for a proper rejection under 35 U.S.C. § 103. Courts have repeatedly held that “it is impermissible . . . simply to engage in *hindsight reconstruction* of the claimed invention, using the Applicant’s structure as a

template and selecting elements from references to fill in the gaps.” In re Gorman, 18 USPQ 1885, 1888 (CAFC 1991).

Applicant suggests that merely because certain isolated aspects from cited references produce a beneficial result, this fact alone does not provide the requisite teaching for combining references under 35 U.S.C. §103. Applicant therefore respectfully requests the Examiner to provide citations to specific sections of the cited references that indicate explicit teachings for combining the cited references.

Further regarding the Examiner’s rejection of dependent claims 29 and 59, for at least the reasons that these claims are dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested.

For at least the foregoing reasons, the Applicant submits that claims 29 and 59 are not unpatentable under 35 U.S.C. § 103 over Chen in view of Szeliski, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicant therefore respectfully requests reconsideration and withdrawal of the rejections of claims 29 and 59 under 35 U.S.C. § 103.

Allowable Subject Matter

In paragraph 3, the Examiner indicates that claims 23 and 53 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant therefore amends claims 23 and 53 in independent form including all of the limitations of the base claim and any intervening claims, to thereby place claims 23 and 53 in condition for immediate allowance.


Summary

Applicant submits that the foregoing amendments and remarks overcome the Examiner's rejections under 35 U.S.C. §102(e) and 35 U.S.C. §103(a).

Because the cited references, or the Examiner's citations thereto, do not teach or suggest the claimed invention, and in light of the differences between the claimed invention and the cited prior art, Applicant therefore submits that the claimed invention is patentable over the cited art, and respectfully request the Examiner to allow claims 1-62 so that the present Application may issue in a timely manner. If there are any questions concerning this amendment, the Examiner is invited to contact the Applicant's undersigned representative at the number provided below.

Respectfully submitted,

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